



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,271	07/19/2001	Thomas E. Creamer	BOC9-2000-0060(195)	2715
40987	7590	05/04/2005	EXAMINER	
AKERMAN SENTERFITT P. O. BOX 3188 WEST PALM BEACH, FL 33402-3188			ANWAH, OLISA	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/910,271	Applicant(s) CREAMER ET AL.	
	Examiner Olisa Anwah	Art Unit 2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Liversidge reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

For instance, claim 37 specifically recites:

An electronic mail client comprising:

a conventional electronic mail processor, said conventional electronic mail processor extracting and displaying message text encapsulated in a received electronic mail;

and a voice conference processor, said voice conference processor identifying a voice conference identifier encapsulated in said received electronic mail, displaying at least one selectable icon in response to detecting said voice conference identifier, and responsive to a selection of said at least one selectable icon, establishing a voice conference call between

Art Unit: 2645

selected conference call nodes specified by said voice conference identifier.

In contrast to claim 37, Disclosure BOC8-2000-0053 merely discloses that when an e-mail is received from an e-mail sender, the e-mail recipient can choose to click on the symbol or icon and a voice/phone conference is initiated. However it is not obvious to have an electronic mail processor and a voice conference processor for performing the claimed extracting, displaying, identifying and establishing features. For these reasons the evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Liversidge reference.

2. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Liversidge reference to either a constructive reduction to practice or an actual reduction to practice because Applicant has failed to provide evidence of due diligence from January 3, 2001 through March 1, 2001.

Art Unit: 2645

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 1-37 are rejected under 35 U.S.C. § 102(e) as being anticipated by Liversidge et al, U.S. Patent Application Publication No. 2002/0076025 (hereinafter Liversidge).

Regarding claim 1, Liversidge discloses an email communication method comprising the steps of inserting in an email message a voice conference identifier comprising a voice conference call list identifying conference call nodes; transmitting said e-mail message to a recipient at a recipient node, wherein responsive to said recipient selecting said voice conference identifier, a voice conference call between selected ones of said identified conference call nodes is established (paragraphs 0134-0137 and 0181-0191).

Art Unit: 2645

Regarding claims 2 and 3, see paragraph 0183.

Regarding claims 4 and 5, see paragraph 0134.

Regarding claim 6, see paragraph 0137.

Regarding claims 7 and 8, see Figures 25 and 28.

Regarding claims 9, 10 and 12-16, see paragraphs 0136, 0137 and 0183.

Regarding claim 11, see Figure 25.

Regarding claim 17, see Figure 28.

Regarding claims 18, 20, and 23-25 see paragraphs 0134-0137 and 0181-0191.

Regarding claim 19, see Figures 25 and 28.

Regarding claims 21 and 22, see paragraph 0183.

Regarding claims 26 and 27, see Figures 25 and 28.

Regarding claims 28, 29, 31-33 and 37 see paragraphs 00136 and 00137. Also see paragraphs 0181-0191.

Regarding claim 30, see Figures 25 and 28.

Regarding claims 34 and 35 see paragraph 0183.

Regarding claim 36, see Figure 28.

Citation of Pertinent Prior Art

5. Gifford et al, U.S. Patent No. 6,549,612 (hereinafter Gifford) is considered pertinent to applicant's disclosure.

Art Unit: 2645

Gifford allows a symbol or icon to be embedded into an e-mail message (see Figure 2). When the email is received, the email recipient can choose to click on the symbol or icon and a voice call is initiated (see columns 10 and 11).

Conclusion

6. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olisa

Art Unit: 2645

Anwah whose telephone number is 571-272-7533. The examiner can normally be reached on Monday to Friday from 8.30 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

O.A.

Olisa Anwah
Patent Examiner
April 29, 2005


FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600